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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,605	01/22/2001	Mario Polegato Moretti	202115US3	9737

7590

04/19/2002

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 04/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/765,605

Applicant(s)

POLEGATO MORETTI, MARIO

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed February 5, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it contains applications that are currently being prosecuted before the Office. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1). Since applications that are in prosecution before the US Patent office and not published are not considered "prior art", the pending applications filed by the applicant are improper for an Information Disclosure Statement. However, the examiner would like to thank the applicant for bringing to his attention the filings of the concurrent applications that applicant believes to be relevant to the prosecution of the instant application as required by 37 CFR 1.56(a).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dassler 4,100,685 in view of Ohashi 4,771,555, Polegato 5,983,524 and Squadroni 6,282,813. Dassler '685

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discloses all the limitations substantially as claimed including the following: a sole 5 with a tread (bottom ground-engaging portion of the sole) with through holes 8 extending through the thickness of the tread (see Figure 1); inserts 9 assembled in the through holes; the inserts 9 having a through holes through them (See col. 3, lines 45-48, must have holes so as not to detract from the desired ventilation) to allow vapor to pass there through. Dassler '685 does not teach the tread being made of leather and at least partially covered in an upward region by a membrane that is permeable to vapor and impermeable to water and sealed in the peripheral regions with respect to the tread, the details with respect to the membrane, the protective layer used to protect the membrane, the undercuts in the inserts; and the inserts assembled by injection molding. Ohashi '555 teaches that inserts used to ventilate a shoe can be made of plastic (see col. 3, lines 56-57, synthetic resin is a plastic material) with undercuts 15 (used to hold the inserts within the sole) to aid in holding the hole open to allow for air to flow through. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use inserts made of plastic, as taught by Ohashi '555, as the inserts of Dassler '685 to allow for air to flow through and ventilate the shoe while supporting the opening in the sole of the shoe. Squadroni '813 teaches that it is desirable to ventilate a shoe sole made of leather (see col. 2, lines 65-68) to allow for the foot of the user to breathe when located within the shoe. Therefore, it would have been obvious to make the shoe sole of Dassler '685 out of leather, or any other known sole material, and ventilate it as taught by the combination above, to allow for the foot of the user to breathe and prevent fluid build-up in the shoe of the user. Polegato '524 teaches that it is desirable to make the ventilated sole of a shoe impermeable to water yet permeable to vapor to allow for the user's foot to breathe. This is accomplished by covering an upward region of the shoe sole by a membrane 315 made of a material which is permeable to vapor and impermeable to water. To further seal or waterproof the shoe sole, Polegato '524 teaches that the membrane can be sealed to the tread in a peripheral region (see col. 5, lines 54-59). The tread and membrane are further sealed peripherally by a peripheral band

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315a and sealed perimetrically by adhesive (see Figures 5-7). Polegato '524 further teaches that a protective layer 316 can be arranged at the upper outlets of through holes to protect the membrane with a vapor permeable or perforated protective layer located above the membrane 318. Polegato '524 also teaches that the sole can be injection molded (See column 6, lines 29-67). Therefore, it would have been obvious to place a vapor permeable membrane with a protective layer, such as that taught by Polegato '524, on the upward side of the sole of the references as modified above to aid in preventing fluid from entering the shoe while keeping the user's foot cool and dry.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margolin 2,347,207 in view of Simmons 4,682,425 and Polegato 5,983,524. Margolin '207 discloses all the limitations of the claims including the following: a sole for a shoe with a tread (that area that is placed on the top side of the outsole); through holes extending entirely through a thickness of the tread (that with 11 located therein); inserts 11 made of plastic (See col. 1, lines 33-37) assembled in the through holes; the insert having through holes 18 located therein allowing for vapor to pass there through; the inserts form antislip and wear preventing protrusions (see Figures 7 and 8, bosses 35 placed in the aeration holes in the sole to aid in holding the hole open would form antislip projections which would aid in gaining grip.). Margolin '207 does not teach that the sole can be made of leather, a vapor permeable layer located on the upward sole region, the details to this membrane, a protective layer located on the membrane and the tread being injection molded. Simmons '425 teaches that a shoe insole can be made of leather (see Abstract) to aid in providing comfort for the user. Therefore, it would have been obvious to make the insole of Margolin '207 out of leather, as taught by Simmons '425, to aid in giving comfort and cushioning to the user during use. Polegato '524 teaches that it is desirable to make the ventilated sole of a shoe impermeable to water yet permeable to vapor to allow for the user's foot to breathe. This is accomplished by covering an upward region of the shoe sole by a membrane 315 made

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of a material which is permeable to vapor and impermeable to water. To further seal or waterproof the shoe sole, Polegato '524 teaches that the membrane can be sealed to the tread in a peripheral region (see col. 5, lines 54-59). The tread and membrane are further sealed peripherally by a peripheral band 315a and sealed perimetrically by adhesive (see Figures 5-7). Polegato '524 further teaches that a protective layer 316 can be arranged at the upper outlets of through holes to protect the membrane with a vapor permeable or perforated protective layer located above the membrane 318. Polegato '524 also teaches that the sole can be injection molded (See column 6, lines 29-67). Therefore, it would have been obvious to place a vapor permeable membrane with a protective layer, such as that taught by Polegato '524, on the upward side of the sole of the references as modified above to aid in preventing fluid from entering the shoe while keeping the user's foot cool and dry.

#### *Response to Arguments*

5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

6. The prior art made of record and relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the

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mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335

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Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
April 17, 2002



**Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.